

## REMARKS

### **§102 rejections**

In the 26 September 2006 Office Action claims 25 - 48 are rejected under §102 as being anticipated by U.S. Patent 5,812,988 (hereinafter, Sandretto). The Examiner has cited the Sandretto document as a reference. The Assignee respectfully traverses the rejections for anticipation in two ways. First, by noting that the rejections fail under both standards of the APA. Second, by noting by noting that the Office Action has failed to establish a prima facie case of anticipation for the rejected claims. More specifically, the Office Action fails to establish a prima facie case of anticipation in as many as three separate ways for every rejected claim.

The first way in which the 26 September 2006 Office Action fails to establish a prima facie case of anticipation for many if not all of the rejected claims is that the Sandretto document fails to describe every element of the claim. MPEP 2131 notes that:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The second way in which the 26 September 2006 Office Action fails to establish a prima facie case of anticipation for many if not all of the rejected claims is that the Sandretto document fails to provide the same level of detail that is present in the claim. MPEP 2131 notes that anticipation requires that:

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The third way in which the 26 September 2006 Office Action fails to establish a prima facie case of anticipation for many if not all of the claims is that the Office Action does not describe the basis in fact or technical reasoning that is required to support the allegations regarding allegedly inherent characteristics contained in the Sandretto document. MPEP 2112 notes that:

"In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the

applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)

The Assignee respectfully submits that the rejection of independent claim 25 can be traversed by noting that Sandretto: is missing elements contained in claim 25, provides insufficient detail regarding elements of claim 25 and that any alleged inherency of elements of claim 25 in the Sandretto document has not been explained. Elements of claim 25 not explicitly or inherently described in the Sandretto document include: integrating data from organization transaction databases. Sandretto also lacks detail regarding integrating data from organization transaction databases and any alleged inherency of integrating data from organization transaction databases has not been explained. The Assignee notes that there are still other ways in which the §102 rejection of claim 25 can be traversed. As a result of these deficiencies, a prima facie case that would support the anticipation rejection of claim 25 has not been established. Claims 26, 27 and 30 - 32 are directly dependent on claim 25 so the traversal of the claim 25 anticipation rejection also serves to traverse the rejection of these claims by establishing that the Examiner has failed to establish a prima facie case of anticipation for the parent claim. Claims 28 and 29 are directly dependent on claim 27 so the traversal of the rejection of claim 27 also serves to traverse the rejection of these claims by making it clear that the Examiner has failed to establish a prima facie case of anticipation for the parent claim.

The Assignee respectfully submits that the rejection of independent claim 33 can be traversed by noting that Sandretto: is missing elements contained in claim 33, provides insufficient detail regarding elements of claim 33 and that any alleged inherency of elements of claim 33 in the Sandretto document has not been explained. Elements of claim 33 not explicitly or inherently described in the Sandretto document include: integrating data from organization transaction databases. Sandretto also lacks detail regarding integrating data from organization transaction databases and any alleged inherency of integrating data from organization transaction databases has not been explained. The Assignee notes that there are still other ways in which the §102 rejection of claim 33 can be traversed. As a result of these deficiencies, a prima facie case that would support the anticipation rejection of claim 33 has not been established. Claims 34 and 36 - 40 are directly dependent on claim 33 so the traversal of the claim 33 anticipation rejection also serves to traverse the rejection of these claims by making it

clear that the Examiner has failed to establish a prima facie case of anticipation for the parent claim.

The Assignee respectfully submits that the rejection of independent claim 41 can be traversed by noting that Sandretto: is missing elements contained in claim 41, provides insufficient detail regarding elements of claim 41 and that any alleged inherency of elements of claim 41 in the Sandretto document has not been explained. Elements of claim 41 not explicitly or inherently described in the Sandretto document include: integrating data from organization transaction databases. Sandretto also lacks detail regarding integrating data from organization transaction databases and any alleged inherency integrating data from organization transaction databases has not been explained. The Assignee notes that there are still other ways in which the §102 rejection of claim 41 can be traversed. As a result of these deficiencies, a prima facie case that would support the anticipation rejection of claim 41 has not been established. Claims 42 - 48 are directly or indirectly dependent on claim 41 so the traversal of the claim 41 anticipation rejection also serves to traverse the rejection of these claims by making it clear that the Examiner has failed to establish a prima facie case of anticipation for the parent claim. The Assignee notes that the rejection of these claims is also moot because the claims have been cancelled without prejudice.

Summarizing the above, the 26 September 2006 Office Action the Assignee respectfully submits that the Examiner has failed to produce the evidence required to establish a prima facie case of anticipation for a single claim. The complete failure to identify anticipation at the claim level clearly illustrates the fact that the cited reference is not even remotely similar to the claimed invention. As noted in MPEP 2112, anticipation requires that a substantial identity be established. Taken together, these failures provide additional evidence that the claimed invention for producing concrete, tangible and useful results is new, novel and non-obvious. The Assignee notes that there are still other ways in which the §102 anticipation rejections in the 26 September 2006 Office Action for claims 25 - 48 can be traversed.

**Statement under 37 CFR 1.111**

37 CFR 1.111 requires that the basis for amendments to the claims be pointed out after consideration of the references cited or the objections made. 37 CFR 1.111 states in part that:

In amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections.

The Assignee notes that this requirement is not relevant to the instant application because, as detailed above, there are no references or objections to avoid. In fact, the opposite is true as the prosecution to date of this application, the cross referenced applications and the applications in the c.i.p. chain has produced references that have documented approximately 200 instances of novelty, non-obviousness and newness relative to the state of the art. The Assignee notes that the primary reason the prior set of claims were amended and/or cancelled was to put the application in a form for issue and allowance by fixing inadvertent clerical errors. The table below shows where some of support for the new claims can be found in the specification.

| New Claims | Support includes:  |
|------------|--|
| 49 - 56    | Page 44, line 1 – Page 65 line 15,<br>FIG. 1, FIG. 6A – 6C, FIG. 7 |
| 57 - 61    | Page 21, line 1 – Page 43, line 35,<br>FIG. 1, FIG. 5A – FIG. 5F   |

### **Reservation of rights**

The Assignee hereby explicitly reserves the right to present the previously modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

### **Conclusion**

The pending claims are of a form and scope for allowance. Prompt notification thereof is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "B.J. Bennett", with a long horizontal flourish extending to the right.

B.J. Bennett, President Asset Trust, Inc.

Date: December 1, 2006